

Serial No. 10/661,894
Reply to Office Action of September 27, 2004

REMARKS

Responsive to the Office Action mailed September 27, 2004, Applicants have studied the Examiner's comments and the cited art. Claims 1-11 are currently pending. In view of the following remarks, Applicants respectfully submit that the application is in condition for allowance.

Information Disclosure Statement

The Office Action asserts that the Information Disclosure Statement (IDS) filed September 12, 2003 "seems to have missing references that was [sic] cited in the parent case. Please check the 09/209,190 application and complete the PTO-1449 in response to this office Action."¹ Applicants note that the MPEP states that "The examiner will consider information which has been considered by the Office in a parent application when examining ... (B) a divisional application filed under 37 CFR 1.53(b) ... A listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent."² Therefore, because all of the references that were cited in Application No. 09/209,190 were considered in the parent application of the current application, Applicants respectfully submit that those references have already been disclosed and will be considered in the current application. However, Applicants desire that all of the information should be printed on the patent to issue from the current application, and submit herewith an Information Disclosure Statement and PTO-1449 that identifies any reference cited in Application No. 09/209,190 that was not identified in the PTO-1449 filed concurrently with the current application.

Specification Amendment

Applicants have amended paragraph [0001] of the Specification to complete the chain of the priority claim to the grandparent application. The amendment does not add any new matter. Applicants have also filed herewith a Supplemental Application Data Sheet for the same purpose.

Double Patenting Rejection

Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5 of U.S. Patent No. 6,363,501 (the '501 patent), from which the current application claims priority as a divisional of a continuation of the '501 patent. Applicants enclose herewith a terminal disclaimer to overcome the double patenting rejections. For this reason, Applicants respectfully request withdrawal of the rejections.

¹ Paper 09172004, para. 1.

² MPEP § 609(I)(A)(2).

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Claim Rejections Under 35 U.S.C. § 102

Claims 1-3, 6, 8, and 10 are rejected under 35 U.S.C. § 102(a) as being anticipated by Jacobson et al., U.S. Patent No. 5,694,399. Applicants respectfully traverse the rejections.

The Office Action has asserted that claims 1-11 of the current application are not patentably distinct from claims 1-3 and 5 of the grandparent application, now U.S. Patent No. 6,363,501 (the '501 patent). The Jacobson reference was considered during the prosecution of the application which issued as the '501 patent and those claims were found patentable over Jacobson. Therefore, by the Office Action's admission that claims 1-11 of the current application are not patentably distinct from those of the '501 patent, claims 1-3, 6, 8, and 10 must also be patentable and non-obvious over Jacobson. For at least this reason, Applicants respectfully request withdrawal of the rejections.

Furthermore, as Applicants argued to achieve allowance of the application issuing as the '501 patent, Jacobson shows a general purpose computer system 112, a hardware unit 200 (characterized by the Office Action as an execution unit), a device 300 (characterized by the Office Action as a peripheral device), and a JTAG interface 250 between the hardware unit 200 and the device 300. The Office Action's interpretation of the features of Jacobson ignores the plain meaning of the term "microcontroller comprising an execution unit with a peripheral device coupled to the execution unit" as claimed by Applicants. The Office Action's characterization of Jacobson's device 300 as Applicants' peripheral device is submitted to be inaccurate in view of the claims and specification.

The specification of the present application is instructive of what a peripheral device is.³ The specification illustrates what Applicant's peripheral devices are in relation to a microcontroller. Peripheral devices as claimed by Applicants are coupled to an execution unit via a bus.⁴ Applicants' peripheral devices include DMA controllers, interrupt controllers, and timer controls.⁵ More to the point, these devices are included in a microcontroller, and are claimed to be part of that microcontroller. This reference to the microcontroller illustrates how one of ordinary skill in the art would read the term "a peripheral device coupled to the execution unit" in the microcontroller.⁶ Thus, the external device of Jacobson does not teach or suggest a peripheral device in "a microcontroller" as claimed by the Applicants.

Claim Rejections Under 35 U.S.C. § 103

Claims 4-5, 7, 9, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jacobson, U.S. Patent No. 5,694,399. Applicants respectfully traverse the rejections.

³ See e.g., Specification, paras. [0012] and [0021].

⁴ See e.g., Figure 2, Bus 100.

⁵ See e.g., Figures 1 and 2.

⁶ See e.g., claim 1: "A microcontroller comprising:..."

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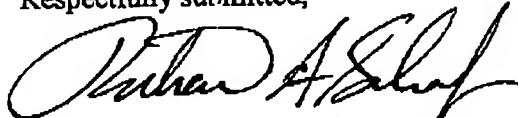
In addition, claims 4-5, 7, 9, and 11 depend from allowable claims 3 and 8 and are therefore also allowable. For this additional reason, Applicants respectfully request withdrawal of the rejections.

CONCLUSION

Applicants respectfully submit that all issues and rejections have been adequately addressed, that all claims are allowable, and that the case should be advanced to issuance.

If the Examiner has any questions or wishes to discuss the claims, Applicants encourage the Examiner to call the undersigned at the telephone number indicated below.

Respectfully submitted,



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